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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,429	11/17/2003	Kelly E. Rollin	003797.00715	2729

28319 7590 04/25/2006

BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET, N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,429	Applicant(s) ROLLIN ET AL.	
	Examiner Etienne P. LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Status

Claims 1-63 are pending. Claims 1-63 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites “detecting changes to the user profile data and storing the modified user profile data back to the PSD without explicit action from a user.” The specification does not contain a clear and concise description of the process of storing the modified user profile data back to the PSD without explicit action from a user such that a skilled artisan can make and use the invention. In fact the following is included in the specification :

paragraph 39:

According to further aspects of the invention, the system will ask the user if he wishes to use the profile stored on the Memory Stick. If he says yes, the new items in the profile will be automatically downloaded to the notebook computer causing the desktop background to be the same digital photograph of his family, and the large document to be downloaded into the corresponding folder on the notebook computer. The user opens the large document and continues working on it.

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paragraph 41:

The computer automatically recognizes that the Memory Stick belongs to the user by reading an account ID code stored on the Memory Stick. The system asks the user to log into the system and he complies. Once he has logged into the system, the system automatically transfers the updated large document and the new desktop background to the personal computer.

The skilled artisan would not know how to make and use the invention because user actions are specified in paragraphs 39 and 41. Furthermore, examiner notes that the word "explicit" is not even included in the specification.

Claims 9 and 18 recite "wherein the user profile data is removed from the computing device when the PSD is disconnected from the computing device." The specification does not contain a clear and concise description of the process of removing the user profile per the above limitation such that a skilled artisan can make and user the invention. In fact the specification states the following:

[0006] In the single mobile computer networked environment, a mobile computer is connected to a local area network. User files are stored on the network and generally accessed from the network. When a user wishes to travel with the mobile computer, he may drag the files into the briefcase in order to have access to them when disconnected from the local area network. The user then accesses the files from the briefcase in order to work on them and saves any changes made to the files into the briefcase. When the user returns and reconnects to the local area network, the user selects the "update" function in the briefcase, and any modified files in the briefcase that have not been updated on the network are copied to the network.

The above specification paragraph states that files are dragged into the briefcase. No mention is made of the user profile.

Claims 2-9 are rejected for being dependent from a rejected base claim.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “detecting changes to the user profile data and storing the modified user profile data back to the PSD without explicit action from a user.” The scope of the invention cannot be determined because it is unclear which method step(s) require user actions and which method steps do not require user actions. Furthermore, the metes and bounds of the claimed invention is not ascertainable because the difference if any, between user actions and explicit user actions is not explained in the specification. In fact the word “explicit” does not appear in the specification at all. For purposes, of this first action on the merits, patentable weight will not be given to “explicit action from a user.”

Claims 2-9 are rejected, at least, for being dependent from a rejected base claim.

Art Rejection Precluded

Claim 9 and 18 are rejected under the first paragraph of USC 112. No art rejection is made in this Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-8, 10, 11, 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No 2004/0268148 issued to Karjala et al (hereafter Karjala), as best examiner is able to ascertain.

Claims 1, 5-7, 10, 14, 15 and 16:

Karjala discloses:

upon detecting a connection of a Portable Storage Device (PSD) [mobile device 10, Fig 2] to a computing device [server 20, Fig 2], reading user profile data from the PSD [mobile device 10 validates SSM server certificate, paragraph 29]; using the user profile data to configure the computing device [client certificate is used authenticate responses to requests, paragraph 26] ; and detecting changes to the user profile data and storing the modified user profile data back to the PSD without explicit action from a user [mobile device 10 is synchronized with SSM server 20, paragraph 26]

Claims 2 and 11:

Karjala discloses wherein the PSD connects to the computing device through a wireless connection [Fig 1, 12]

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Claims 4 and 13:

Karjala discloses a smart device [mobile device 10, Fig 1]

Claims 8 and 17:

Karjala discloses wherein the storing step occurs in direct response to the modification of the user profile data [paragraph 37]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karjala in view of Applicant's admitted prior art (hereafter AAPA), as best examiner is able to ascertain.

Claims 3 and 12:

Karjala discloses the elements of claim 1/10 as noted above but does not disclose wherein the PSD is a dumb device. AAPA discloses wherein the PSD is a dumb device [paragraph 43].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Karjala to include wherein the PSD is a dumb device for the purpose of providing a record of the data in a backup storage device.

Rejection of claims 19-63 can be made on the same basis as above claim rejections.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

4/21/2006

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', is written over the typed name and date.